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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
50277-2319

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Application Number	Filed
10/733,102	December 10, 2003

on __August 11, 2010__

Signature __/KarlTRees#58983/__

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Art Unit	Examiner
2625	McLean, Neil R.

Typed or printed __Karl T. Rees__
name

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
    (Form PTO/SB/96)

☑ attorney or agent of record.
    Registration number __58,983__.

☐ attorney or agent acting under 37 CFR 1.34.

    Registration number if acting under 37 CFR 1.34 _____

/KarlTRees#58983/
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August 11, 2010
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of __1__ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Osama Elkady, et al.	)	Confirmation No.: 9183
	)	
Serial No.:	10/733,102	)	Examiner: McLean, Neil R.
	)	
Filing Date:	December 10, 2003	)	Art Unit: 2625

For: GENERATING MERGED DOCUMENTS

Mail Stop AF, Pre-Appeal Conference
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

I.   STATUS OF CLAIMS

Claims 1–29 and 31 are pending. All of the pending claims were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 7,099,027 (hereinafter "*Barry*") in view of U.S. Patent No. 7,202,972 (hereinafter "*Schwier*").

II.   THE REJECTIONS ARE BASED ON CLEAR ERRORS

The rejections of the Final Office Action mailed 11 May 2010 ("FOA") are based on at least the clear legal and factual errors discussed in the following sections.

A. CLAIM 1

1. Neither reference teaches that a merge utility responds to a request to merge a document in an original format with a document in a merge format

Claim 1 recites "receiving, at a merge utility executing on a computer system, a request to merge a first merge document in a merge format with a second document in an original format." While the original format "is not supported by the output device, and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device," the merge format "is a format that is supported by the output device, and therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device." For example, the request may be to merge a document in a word-processing format (an example "original format") with a document in a PCL format (an

example "merge format"). One or more of the steps of Claim 1 are performed "in response to the request" to merge the two documents of different formats.

The FOA appears to allege that the request recited in Claim 1 is an inherent aspect of *Schwier*'s system. FOA at 3. However, the allegation is clearly legally erroneous, in that it is based on nothing more than speculation that "in order to merge the system must receive a merge command." Even if *Schwier* did explicitly teach some form of a "merge request" of some form, the FOA still fails to produce any evidence that this "request" is the same kind of request as recited in Claim 1—that is, a "request to merge a first merge document in a merge format with a second document in an original format."

In any event, the allegation is also clearly factually erroneous. In *Schwier*, no entity is ever requested to merge a document in a merge format with a document in an original format, within the meanings recited in Claim 1. Thus, there is no reason why *Schwier* would have implied the request recited in Claim 1. For example, while Variable Data 11 and Static Data 12 are merged by Application 10, *Schwier* at FIG. 2, neither Variable Data 11 nor Static Data 12 are in a "merge format" as recited by Claim 1. Rather, Variable Data 11 and Static Data 12 appear to be Office-compatible documents such as "a Word document, data blank, [or] an Excel document." *Schwier* at col. 5, lines 27–38. Meanwhile, Variable Data 15 and Static Data 16 are merged at the printing device 7, *Schwier* at FIG. 2. Aside from the fact that Claim 1's merger does not take place at the output device, both Variable Data 15 and Static Data 16 are at the time or merger already in PCL format, and therefore the merger does not involve an "original format" within the meaning of Claim 1.

The absence of such a request from the combination of *Barry* and *Schwier* is far from trivial. One certainly may, as the FOA appears to be alleging, achieve results similar to those achieved by Claim 1 by converting an original document to a merge document, per *Scwhier*, and then merging the converted document with another merge document, per *Barry*. However, Applicants are not claiming an end result, but a method for achieving a result. Whereas the proposed combination of references would require separate requests to separate components in order to accomplish the conversion and merger, the method of Claim 1 facilitates the use of a single merge utility to achieve both the conversion and the merger. The cited references simply fail to teach or suggest a

merge utility whereby one may merge a document in an original format with a document in a merge format in response to a request to a single merge utility.

> 2. Neither reference features a merge utility that causes a document to be
>   converted from an original format to a merge format

Claim 1 further recites that "in response to the request, the merge utility caus[es] the second document to be converted from the original format to the merge format to create a second merge document." Neither *Barry*'s nor *Schwier*'s alleged merge utilities cause an input document to be converted from an original format to a merge format.

The FOA, at page 3, appears to allege that *Schwier* teaches such a merge utility because, in *Schwier*, a Word document is eventually converted to a PCL document. While Applicants agree that it is clearly well known to convert a Word document to a PCL document, the allegation is nonetheless clearly factually incorrect, in that the component responsible for causing the conversion in *Schwier* is not a "merge utility" within the meaning of Claim 1.

In *Schwier*, conversion from an original format to a merge format is caused by a PCL converter 18. *Schwier* at FIG. 2; col. 7, 7–9; *see also* FIG. 9 (illustrating the converter as "EMF->PCL Convertor 58"). This converter is not a merge utility. In fact, PCL converter 18 functions in the opposite manner of a merge utility, in that PCL converter 18 filters or splits a single data stream into multiple data streams. *Schwier* at FIG. 2; col. 7, 7–9. Meanwhile, the only components of *Schwier* that perform a merger, application 10 and printer 7, do not cause or perform any conversion operations. Thus, *Schwier* cannot possibly teach or suggest that a merge utility "caus[es] the second document to be converted from the original format to the merge format to create a second merge document" as recited in Claim 1.

B. CLAIM 9

Dependent Claim 9 recites that "causing the second document to be converted from the original format to the merge format to create the second merge document includes: . . . passing [a] set of conversion instructions from the merge utility to the first document authoring application . . . [that] cause the first document authoring application to generate the second merge document based on said set of conversion instructions." Thus, Claim 9 teaches that, in response to the merge request recited in Claim 1, a merge

utility passes conversion instructions to the document authoring application in which the second document was created. These instructions cause the document authoring application to convert the second document from the original format to the merge format.

The FOA alleges that these steps of Claim 9 are taught in *Schwier* at FIG. 2 and column 4, lines 15–20. The FOA is clearly factually erroneous, for at least the reason that, while this passage of *Schwier* may state that an application sends an instruction to a PCL convertor 18 to convert a document, PCL convertor 18 is not a "document authoring application" in any sense, much less within the meaning recited in Claim 1. That is, Claim 1 recites that "the second document was created in [the] original format by [the] first document authoring application." *Schwier* does not teach or suggest that PCL convertor 18 was used to create any alleged "original document."

Moreover, *Schwier*'s application does not pass the instruction to the PCL convertor until after the application has already performed a merge operation, *e.g.* *Schwier* at FIG. 2, whereas Claim 9 recites that this step occurs as part of converting the second document prior to merging the first merge document with the second merge document. In other words, the instructions in *Schwier* are to convert an already combined output document, not a single input document as recited in Claim 9. Thus *Schwier* clearly does not teach or suggest the above quoted element of Claim 9.

C. CLAIM 10

Claim 10 recites that the request of Claim 1, as discussed above, "contains information about the first document authoring application." Claim 10 continues, "the merge utility generat[es], based on the information about the first document authoring application, a set of conversion instructions to convert the second document into said second merge document." Therefore, the method of Claim 10 recites that a merge utility generates conversion instructions based at least upon information about a document authoring application that was included in the original merge request. The conversion instructions may then be used to cause the conversion of the second document by the document authoring application, similar to Claim 9.

The cited references fail to teach or suggest such a method, for at least the reasons that, as explained above, the references fail to teach the merge request of Claim 1. The FOA nonetheless alleges that *Schwier*'s merge request "contains information about the

first document authoring application" because *Schwier* states in col. 4, lines 25–26, that "the referencing is thereby particularly controlled via data that are input via a user interface." Clearly, the FOA is in error. This passage has nothing to do with a merge request, much less "information about the first document authoring application." Clearly, the passage cannot teach or suggest that a merge request "contains information about the first document authoring application."

The FOA further alleges that *Schwier* teaches that a set of conversion instructions is generated "based on the information about the document authoring application" included in the merge request because of "the program code or device which enables the PCL converter 18 in Figure 2." Again, the FOA is clearly in error. *Schwier* does not teach or suggest that the "program code or device which enables the PCL converter 18" is generated "based on the information about the document authoring application" included in the merge request. Thus *Schwier* does not teach or suggest the above quoted elements.

D. THE REMAINING CLAIMS

All pending claims not discussed above either depend from, or recite features similar to, the claim features discussed above. Therefore, for at least one or more of the same reasons discussed above, the rejection as to these remaining pending claims is based on one or more clear legal or factual errors.

III. CONCLUSION

For at least these above reasons, the Office's rejection of each of the pending claims is based on clear legal and factual errors. Accordingly, the cited references fail to teach or suggest at least one element of each pending claim. Applicants therefore request that the Office remove the current rejection of the pending claims.

Respectfully submitted,

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